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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91185884
Party	Defendant Imagini Holdings Ltd
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Submission	Opposition/Response to Motion
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Date	09/15/2009
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Dating DNA LLC, Opposer/Respondent, v. Imagini Holdings Ltd., Applicant/Petitioner.	Opposition No.: 91185884 **APPLICANT/PETITIONER'S OPPOSITION TO OPPOSER/RESPONDENT'S MOTION TO REOPEN DISCOVERY AND RE-SET TRIAL DEADLINES**

The Interlocutory Attorney has stated that "The parties should not file any paper which is not germane to the motion to compel." Applicant/Petitioner believes, however, that this Opposition to Opposer/Respondent's Motion to Reopen Discovery and Re-Set Trial Deadlines is germane to the Motion to Compel because Opposer's Initial Disclosures were not timely sent and therefore whether or not Opposer can seek discovery at all is related to the timing of the entire proceeding.

Applicant/Petitioner Imagini Holdings Ltd. ("Applicant") hereby opposes Opposer/Respondent Dating DNA LLC's ("Opposer") Motion to Reopen Discovery and Re-set Trial Deadlines ("Motion"). Opposer has not met the "excusable neglect" standard pursuant to TBMP §509.01(b)(1) to justify reopening discovery and resetting the remaining trial dates. Indeed, Opposer has given no details on the reasons for its neglect in this proceeding and has merely alleged that "it was the result of an oversight." Motion at 3. Applicant further notes for the Board that Opposer has not served its Plaintiff's Pretrial Disclosures which were due on August 26, 2009. There is no justification for

Opposer's allowing this deadline to lapse as well and Applicant requests that this deadline likewise not be reopened.

STATEMENT OF FACTS

Applicant submits the following recitation of facts to assist the Board in making its determination and to correct for the record a number of inaccuracies in Opposer's Statement of Facts in its Motion.

1. Applicant confirms that the subject opposition was filed on August 19, 2008.

2. Applicant confirms that its Answer and Counterclaim was filed on October 8, 2008.

3. Opposer requested an extension of time to answer the counterclaim from Applicant on November 12, 2008, three days before the answer was due, and Applicant granted its consent to the extension that day. Declaration of Beth Goldman in Support of Applicant/Petitioner's Opposition to Opposer/Respondent's Motion to Reopen Discovery and Re-set Trial Deadlines ("Goldman Declaration") at Paragraph 2. Applicant confirms that Opposer filed a Stipulated Motion for Extension of Time for Opposer to Answer the Counterclaim on November 13, 2008.

4. Applicant confirms that Opposer filed its Answer to Counterclaim on December 11, 2008.

5. Applicant emailed Mr. Carmony, Opposer's representative at that point in the proceedings, on January 8, 2009 to schedule a discovery conference. Applicant sent a follow-up email to Mr. Carmony on January 9, 2009. Goldman Declaration at Paragraph 3.

6. On January 13, 2009, Applicant and Opposer participated in the required discovery conference via telephone in which they discussed the merits of the proceeding

and possible settlement. Opposer's current counsel, Colburn Stuart, represented Opposer in the discovery conference. Goldman Declaration at Paragraph 4. Applicant emailed Mr. Stuart after the phone conference as proof and confirmation of completion of the discovery conference requirement. *See* Exhibit A to Goldman Declaration. Applicant does not understand why Opposer contends in its Motion that "Opposer and Applicant . . . failed to participate in a discovery conference, as required." Motion at 2.

7. On February 12, 2009, Applicant served Opposer with its Initial Disclosures. Applicant formally served Mr. Carmony as Mr. Stuart had not yet made a formal appearance in the proceeding with the Board. Applicant, however, did send Mr. Stuart a courtesy copy on that date via email. Goldman Declaration at Paragraph 6. Applicant received no response from Opposer and was not served with its Initial Disclosures by the February 12, 2009 deadline.

8. On May 7, 2009, after several attempts to contact Opposer regarding possible settlement with no response, Applicant served Opposer with discovery requests.

9. Applicant confirms that Opposer served documents and responses to Applicant's discovery requests on June 9, 2009. Applicant confirms that, on that same date, Opposer served its discovery requests on Applicant along with a letter from Kevin Carmony, C.E.O. of Dating DNA, LLC to Alex Willcock, C.E.O. of Applicant. The letter discussed Mr. Carmony's litigation record and possible settlement of this matter.

10. Applicant confirms that Kevin Carmony and Alex Willcock conducted oral settlement discussions via telephone on July 10, 2009. A further call was scheduled for July 14, 2009 but Mr. Willcock had to postpone it.

11. Applicant confirms that discovery closed on July 12, 2009. Opposer did not request to extend the discovery period.

12. On July 14, 2009 – the date that Applicant's discovery responses would have been due if Opposer had properly served its Initial Disclosures prior to its discovery requests as required under C.F.R. 2.120(a)(3) – Applicant sent Opposer an email indicating that it was not going to respond to Opposer's discovery requests.

13. Applicant confirms that Opposer served its Initial Disclosures upon Applicant on July 29, 2009, five and a half months after the due date for the Initial Disclosures had passed, and more than two weeks after the discovery period had closed and after Applicant had informed Opposer that it would not be responding to Opposer's discovery requests. Opposer gave no details on the reason for its delay in serving its Initial Disclosures, merely stating that it was due to "some clerical error." *See* Exhibit B to Goldman Declaration. After serving its untimely Initial Disclosures, Opposer has made no attempt to serve its discovery requests.

14. Applicant confirms that Opposer emailed Applicant requesting information on when Applicant would be serving its discovery responses. The date of this email was August 5, 2009, see Exhibit C to Goldman Declaration, not August 4, 2009 as stated in Opposer's Motion.

15. Applicant confirms that Ms. Goldman was on vacation from August 3-10, 2009. Ms. Goldman had an out of office automated response indicating that senders should contact Ms. Goldman's associate, Chelseaa Bush, and provided Ms. Bush's email address in the event that the sender required immediate assistance. Opposer did not contact Ms. Bush. Goldman Declaration at Paragraph 9.

16. On the day of Ms. Goldman's return to the office, Ms. Goldman telephoned counsel for Opposer. Goldman Declaration at Paragraph 10. There was not simply an exchange of email messages per Opposer's statement in Paragraph 15 of its Motion. Rather, Opposer and Applicant first engaged in a telephone conversation on August 10,

2009. During the telephone conversation, Opposer's counsel requested Applicant's discovery responses, stating that as he had now sent the Initial Disclosures, the discovery responses should be forthcoming. Ms. Goldman explained the rules regarding the requirement that a party serve Initial Disclosures *prior* to service of discovery requests and that the discovery period had closed by the time Opposer's Initial Disclosures were sent. Counsel for Opposer requested that Ms. Goldman send him the rule evidencing the Initial Disclosure requirement. Ms. Goldman emailed counsel for Opposer the relevant rule that day. Goldman Declaration at Paragraph 10.

17. Since forwarding the relevant rule, Applicant has received no further comments from Opposer.

18. On August 25, 2009, Opposer filed the subject Motion. Opposer has not requested that the Board reopen its deadline to serve its Initial Disclosures. Opposer had not asked Applicant to extend the discovery period prior to the closing of the discovery period and has not asked Applicant to reopen discovery and re-set the trial dates prior to the filing of this Motion.

19. Opposer did not attach proof of service in its August 25, 2009 filing of this Motion with the Board and the Board was forced to issue an order on September 2, 2009 requiring proof of service.

20. Plaintiff's Pretrial Disclosures were due on August 26, 2009. To date, Opposer has not served Applicant with its Pretrial Disclosures.

DISCUSSION

In this proceeding, Opposer has disregarded *three* deadlines set by the Board; the deadline to serve Initial Disclosures, the deadline to take discovery, and now the deadline to serve its Pretrial Disclosures which were due August 26, 2009. In order to re-open

these deadlines, Opposer must show "that its failure to act during the time previously allotted therefore was the result of excusable neglect." TBMP § 509.01(b)(1). The excusable neglect determination must take into account (1) the danger of prejudice to the nonmovant, (2) the length of the delay and its potential impact on judicial proceedings, (3) the reason for the delay, including whether it was within the reasonable control of the movant, and (4) whether the movant acted in good faith. *Id.*; *Pioneer Investment Services Company v. Brunswick Associates Ltd. Partnership*, 507 U.S. 380 (1993), adopted by the Board in *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997). The third factor in this determination, the reason for the delay on the part of the movant, has been held to be one of the most important of the factors. *Id.*

Despite the importance of this factor, Opposer gives no reasons for its delay in serving Initial Disclosures and its ultimate need to reopen discovery, alleging merely that "it was the result of an oversight." Motion at 3. A bare statement of "oversight," however, does not meet the Board's standard for demonstrating excusable neglect. *Atlanta-Fulton County Zoo Inc. v. De Palma, 45* USPQ2d 1858 (TTAB 1998) (failure to timely move to extend testimony period was due to counsel's oversight did not justify party's inaction or delay). Indeed, TBMP § 509.01(b) is explicit that "a party moving to reopen its time to take required action must set forth with particularity the detailed facts upon which its excusable neglect claim is based; mere conclusory statements are insufficient." Was the oversight due to a docketing error? Was it due to a personal emergency? Opposer gives no such reasons. Opposer's conclusory statement of "oversight" should be held insufficient to justify its request to reopen the discovery period and re-set the trial dates.

Indeed, Opposer's bare assertion of "oversight" without any further explanation for the inaction on its part only serves to demonstrate Opposer's casual attitude toward

the Board's rules and its deadlines. First, Opposer has allowed *three* crucial deadlines in this proceeding pass without taking the necessary actions. Second, Opposer has attempted to serve discovery requests on Applicant without making its prerequisite disclosures. Third, in making this Motion, Opposer has argued that Initial Disclosures essentially do not matter, that they are "routine in nature" and that failure to serve them was "harmless error." As justification for not serving Initial Disclosures, Opposer states that: "[H]ad this same information [in the initial disclosures] been served prior to Applicant's discovery requests rather than after, it likely would have had no effect on the substance of Applicant's discovery requests." Motion at 3. Opposer misses the point here; even it believes that Board requirements are "routine" or have "no effect," all parties to a Board proceeding are required to adhere to the Board's requirements. Fourth, Opposer's filing of this Motion was inadequate; it did not include proof of service of the Motion for the Board, forcing the Board to issue an order requiring proper proof of service. Contrary to Opposer's apparent belief, it is not exempt from the rules on the timing and process for discovery and the necessity for disclosures.

Rather than provide explanation for its own neglect and disregard of the rules, Opposer attempts to blame Applicant for its inaction and failure to comply with the Board's rules. Opposer suggests that it is *Applicant's* duty to ensure that Opposer takes the necessary actions properly to serve its discovery before the discovery period closes. By not reminding Opposer of its responsibilities to properly serve disclosures, Opposer claims that Applicant is "gaming the system" and acting in bad faith. Motion at 4. Opposer states that if Applicant "harbored a genuine concerned [sic] about not having received Opposer's initial disclosures, Applicant should have filed a motion to compel such disclosures prior to the close of discovery." *Id.*

Applicant rejects these allegations; it is *Opposer's* responsibility to familiarize itself with the rules and meet its deadlines if it wants to avail itself of the discovery

process. Opposer filed the subject Opposition against Applicant - Opposer should therefore be required to prosecute its case according to the rules without guidance from Applicant. Indeed, such arguments blaming an applicant for an opposer's failures have been seen as "border[ing] on frivolous" by courts evaluating similar claims for excusable neglect. *See Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551 (Fed. Cir. 1991) (rejecting Opposer's claim of excusable neglect based on Opposer's reliance on Applicant's silence and inaction and noting that Applicant was "under no affirmative duty to remind [Opposer] that it had failed to present its case or to properly seek an extension of [Opposer's] testimony period").

Opposer makes several allegations in its Motion that Applicant has not acted in good faith. Opposer seems to suggest that Applicant would only be acting in good faith if it disregarded the Board's rules and accepted service of Opposer's discovery requests prior to service of Opposer's Initial Disclosures. Applicant does not believe this is required in order for it to act in good faith.

Applicant submits to the Board that it has, in fact, acted in good faith in this discovery process and has in no way derogated from its obligations in this case. Applicant has at all times openly communicated with Opposer and even provided Opposer with the governing rules to assist it in this matter. Applicant served Opposer with the required disclosures by the set deadline. Contrary to Opposer's claims, Applicant is not aware of any obligation it may have to provide Opposer with advance notice prior to its due date that it would not be sending discovery responses. In fact, when a party has a general objection to a propounding party's discovery, the Board allows for the party to make a general objection so long as it is "within the time for (and instead of) serving answers and specific objections." *See, e.g.*, TBMP § 405.03(e) (regarding the remedy for excessive interrogatories). This is exactly what Applicant did. Applicant had Opposer's

discovery requests "in excess of thirty days prior to notifying Opposer that it did not intend to respond," Motion at 4, because under TBMP § 403.03 Applicant had thirty-*five* days to respond to the discovery requests. When the due date arrived, Applicant made a general objection to Opposer that it would not serve responses due to improper service. Unlike Opposer, Applicant has, throughout this proceeding, complied in good faith with both the substance and formal requirements of the rules attendant to this proceeding.

Indeed, Applicant served its Initial Disclosures on February 12, 2009, the date they were due, via both mail and email to be sure that both Opposer and its counsel (who had not yet formally appeared) received a copy. At that time, one would opine that Opposer should have realized it might have a parallel obligation to send its own Initial Disclosures if it were being diligent in this matter. Instead, Opposer neglected its obligation. Then, over five months later, when Opposer was informed by Applicant that discovery responses would not be forthcoming because of Opposer's failure to serve Initial Disclosures, Opposer asked Applicant's counsel for a copy of the rules that supported Applicant's refusal to provide responses. Applicant provided Opposer with the relevant rule that same day. Why hadn't Opposer familiarized itself with the rules governing the proceeding Opposer itself had initiated prior to this late date?

Now, more than five months after its date to serve Initial Disclosures has passed, more than six weeks after discovery has closed and just as its Pre-trial Disclosures are due, Opposer has the temerity to come before the Board to ask that it reopen the discovery period and re-set the trial dates. Opposer does not even request that its deadline to serve Initial Disclosures be reopened, assuming that it can simply serve them five months late without any consent from Applicant or leave of the Board. Opposer should not be allowed to have such leeway with the deadlines in this proceeding.

Applicant further submits that it has been prejudiced by Opposer's neglect and disregard in this proceeding. Applicant has had to expend its time and resources alerting Opposer to the rules and trying to convince Opposer that it must comply with them.

Applicant therefore requests that Opposer's disregard of the rules not be accepted as "excusable neglect" and its Motion to Reopen Discovery and Re-set Trial Deadlines be denied.

Applicant believes it has amply demonstrated why the Board should deny Opposer's Motion to Reopen Discovery and Re-set the Trial Deadlines. If the Board determines that Opposer's companion Motion to Compel should be granted, however, effectively extending the discovery period for Opposer[1], then Applicant respectfully requests that the Board reopen and extend the discovery period for both parties, as it would prejudice Applicant to have discovery effectively reopened for Opposer and not for Applicant.

Dated: September 15, 2009

ORRICK HERRINGTON & SUTCLIFFE LLP

By: _____

Beth M. Goldman
Chelseaa E.L. Bush

Attorneys for Applicant/Petitioner
405 Howard Street
San Francisco, CA 94105
(415) 773-5700

[1] Opposer served its Initial Disclosures after the close of the discovery period. Therefore, accepting its Initial Disclosures and requiring a response to its discovery requests is effectively extending its discovery period.

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **APPLICANT/PETITIONER'S OPPOSITION TO OPPOSER/RESPONDENTS MOTION TO REOPEN DISCOVERY AND RE-SET TRIAL DEADLINES** is being served upon counsel for Opposer/Respondent by First Class Mail on this 15th day of September 2009, by placing the same in an envelope addressed as follows:

Colbern C. Stuart, III, Esq.
Lexevia, PC
4139 Via Marina PH 3
Marina del Rey, CA 90292

By: 
Chelseaa Bush

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Dating DNA LLC, Opposer/Respondent, v. Imagini Holdings Ltd., Applicant/Petitioner.	Opposition No.: 91185884 **BETH GOLDMAN'S DECLARATION IN SUPPORT OF APPLICANT/PETITIONER'S OPPOSITION TO OPPOSER/RESPONDENT'S MOTION TO REOPEN DISCOVERY AND RE-SET TRIAL DEADLINES**

I, BETH M. GOLDMAN, declare as follows:

1. I am a partner in the law firm of Orrick, Herrington & Sutcliffe, LLP. This declaration is based upon personal knowledge and facts gathered upon my request and under my supervision; if called as a witness, I could testify to these facts.

2. Opposer requested an extension of time to answer the counterclaim from Applicant on November 12, 2008, three days before the answer was due, and Applicant granted its consent to the extension that day.

3. Applicant emailed Mr. Carmony, Opposer's representative at that point in the proceedings, on January 8, 2009 to schedule a discovery conference. Applicant sent a follow-up email to Mr. Carmony on January 9, 2009.

4. On January 13, 2009, Applicant and Opposer participated in the required discovery conference via telephone in which they discussed the merits of the proceeding and possible settlement. Opposer's current counsel, Colburn Stuart, represented Opposer in the discovery conference.

5. I emailed Mr. Stuart after the phone conference as proof and confirmation of completion of the discovery conference requirement. Attached as Exhibit A is a true and correct copy of the email sent by me to Mr. Stuart on that date.

6. On February 12, 2009, Applicant served Opposer with its Initial Disclosures. Applicant formally served Mr. Carmony as Mr. Stuart had not yet made a formal appearance in the proceeding with the Board. Applicant, however, did send Mr. Stuart a courtesy copy on that date via email.

7. Opposer gave no details on the reason for its delay in serving its Initial Disclosures, merely stating that it was due to "some clerical error." Attached as Exhibit B is a true and correct copy of the email sent by counsel for Opposer regarding the "clerical error."

8. Applicant confirms that Opposer emailed Applicant requesting information on when Applicant would be serving its discovery responses. The date of this email was August 5, 2009, not August 4, 2009 as stated in Opposer's Motion. Attached as Exhibit C is a true and correct copy of the August 5, 2009 email from Opposer requesting information on the discovery responses.

9. I was on vacation from August 3-10, 2009. I had an out of office automated response indicating that senders should contact my associate, Chelseaa Bush, and provided Ms. Bush's email address in the event that the sender required immediate assistance. Opposer did not contact Ms. Bush.

10. On the day of my return to the office, I telephoned counsel for Opposer. There was not simply an exchange of email messages per Opposer's statement in Paragraph 15 of its Motion. Rather, I first engaged in a telephone conversation with counsel for Opposer on August 10, 2009. During the telephone conversation, Opposer's

counsel requested Applicant's discovery responses, stating that as he had now sent the Initial Disclosures, the discovery responses should be forthcoming. I explained to him the rules regarding the requirement that a party serve Initial Disclosures *prior* to service of discovery requests and that the discovery period had closed by the time Opposer's Initial Disclosures were sent. Counsel for Opposer requested that I send him the rule evidencing the Initial Disclosure requirement. I emailed counsel for Opposer the relevant rule that day.

I declare under penalty of perjury that the foregoing is true and correct.

Executed this 15th day of September, 2009 at San Francisco, California.

Dated: September 15, 2009

Beth M. Goldman

EXHIBIT A

Goldman, Beth

From: Goldman, Beth
Sent: Tuesday, January 13, 2009 5:11 PM
To: Cole Stuart
Cc: SF trademark group
Subject: Dating DNA v. VISUAL DNA

Hi Cole,
This is to confirm we had our requisite discovery conference this afternoon. You agreed to discuss the use of DNA with your client and I agreed to discuss your client's settlement offer, that is, to define a field of use or accept a license. We will have another conversation in a week or so.
Beth

ORRICK

BETH M. GOLDMAN
Partner

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THE ORRICK BUILDING
405 HOWARD STREET
SAN FRANCISCO, CA 94105

tel 415-773-4580
fax 415-773-5759
beth.goldman@orrick.com

www.orrick.com

EXHIBIT B

Goldman, Beth

From: Allen M. Lee [allen.lee@lexevia.com]
Sent: Wednesday, July 29, 2009 2:30 PM
To: Goldman, Beth
Cc: 'Cole Stuart'; 'Deve McLaughlin'
Subject: Dating DNA v. Imagini (VisualDNA)
Attachments: Initial Disclosure.pdf

Hi Beth,
Hope all is well. By way of introduction, I am assisting Cole Stuart on the Dating DNA v. Imagini matter. You had advised us that you did not receive our Initial Disclosures. Based on my investigation of this matter, our client had provided us with their Initial Disclosures for delivery to you, but due to some clerical error on our part it never made it out the door - our apologies. We will resend the Initial Disclosures today via first class mail. Attached for your convenience is an electronic copy.

Best,

Lexevia
Enlightened. Law.
Allen M. Lee, Esq.
1571 W. El Camino Real Ste. 40 | Mountain View, CA 94040
allen.lee@lexevia.com | P: 650.254.0758 | F: 650.967.1851

EXHIBIT C

Goldman, Beth

From: Cole Stuart [cole.stuart@lexevia.com]
Sent: Wednesday, August 05, 2009 1:17 PM
To: Goldman, Beth
Cc: Allen M. Lee
Subject: Re: Dating DNA v. Imagini (VisualDNA)
Importance: High

Beth:

I you had an enjoyable vacation.

As DatingDNA has served its Initial Disclosures, please advise when you will be serving Imagini's responses to DatingDNA's discovery requests.

You are also likely aware that our clients have been discussing settlement proposals. Please advise if your client is amendable to formal mediation or other settlement discussions.

Best,

Cole

On 7/14/09 9:52 AM, "Goldman, Beth" <Beth.Goldman@orrick.com> wrote:

> Hi Cole,
> Please note we are not responding to Dating DNA's discovery requests because Dating DNA has not served its Initial Disclosures upon us. Pursuant to the Rules, the Initial Disclosures must be served before discovery may be served.
> Best regards,
> Beth

<http://www.orrick.com/>
Beth M. Goldman
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beth.goldman@orrick.com
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"EMF <orrick.com>" made the following annotations.

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **DECLARATION OF BETH M. GOLDMAN IN SUPPORT OF APPLICANT/PETITIONER'S OPPOSITION TO OPPOSER/RESPONDENTS MOTION TO REOPEN DISCOVERY AND RE-SET TRIAL DEADLINES** is being served upon counsel for Opposer/Respondent by First Class Mail on this 15th day of September 2009, by placing the same in an envelope addressed as follows:

Colbern C. Stuart, III, Esq.
Lexevia, PC
4139 Via Marina PH 3
Marina del Rey, CA 90292

By: 
Chelseaa Bush